

REMARKS/ARGUMENTS

Claims 1-6 remain in this application.

In response to the Office Action of July 7, 2004, Applicant respectfully requests re-examination and reconsideration of the application for patent pursuant to U.S.C. 132.

Claims 1-6 are under consideration in this Office Action.

Objections to the drawings

The Examiner has objected to drawings because the shading makes details unclear after scanning. In response, a new replacement sheet clearly illustrating the features of FIGURE 1 has been submitted herewith. New FIGURE 1 is structurally identical to the originally filed FIGURE 1, therefore it should not be construed as new matter.

Claim Objections

Claim 1 stands objected to because a period was missing at the end of the claim. Claim 1 submitted herewith has been amended to include a period at the end. Therefore, it is respectfully requested that the objection to claim 1 be withdrawn.

Rejection under 35 USC 102(b)

(A) Claim 1 and 4 are rejected under 35 U.S.C. 102(b) as being

anticipated by Napiorkowski et al USP 5,567,916, (hereinafter Napiorkowski). The reference Napiorkowski is analyzed by the Examiner as teaching a wire grommet (2) comprising an outer peripheral member (4) and an inner perforate member (10, 18), said inner perforate member being formed as a disk having a center point and a plurality of radial slits (20) extending therethrough and a corresponding number of radially dispersed openings (14, 16). Examiner indicates "whereby upon passage of said plural disparate combination of cables therethrough, said inner perforate member (18) returns to its original configuration for strain-free engagement of plural disparate cable combinations, due to the elastic material of construction." The Examiner to points to col. 4, line 29-32, Figs 6-7 for support.

Firstly, Applicant respectfully submit that col. 4, line 29-32 and Figures 6-7 illustrate an alternative embodiment utilizing membrane surfaces (42) and (44) containing a gel (52) which flows completely around the wires inserted therethrough to effect the desired seal. This is in contrast to the preferred embodiment of Figures 1-5 upon which reference numbers (2, 4, 10, 14, 16, 18, 20) correspond. Therefore, it is not clear as to which embodiment, or both, Examiner is relying upon for the rejection. In order to expedite prosecution, both embodiments have been addressed herein by Applicant.

In the preferred embodiment of Napiorkowski, FIGS. 1-5 depict a grommet (2) comprising an outer peripheral section (4) and a central section (6). The outer peripheral section (4) including a groove (8) for attaching the grommet to an aperture surface. The central section (6) in the form of a membrane, which has a first surface (10), being pre-creased with a plurality of circles (14) and (16), and an opposite second surface (12), also pre-creased with a star-like pattern in the form of a plurality of wedges (18) which extend radially from an apex (22), see col. 3, lines 7-47.

This embodiment of Napiorkowski in FIGS. 1-5, disclose the position of the pattern (10), relative to the position of the pattern on the surface (12), is important in order to practice this invention. For example as shown in FIG. 4, the circle (14), on surface (10) having a center (26) coincides with a radial edge (20) of a wedge (18) on the opposite surface (12). Similarly, the circle (16) on the surface (10) having a center (28) coincides with another radial edge (20) of a wedge (18) on the surface.

This is in contrast to the present invention as set forth in the instantly amended claims, which provides an inner perforate member constructed and arranged to provide strain-free engagement with a plurality of disparate cable combinations in a manner which permits said inner perforate member to return to its original configuration. See

particularly the specification beginning at p.6, lines 3-6, wherein it states "The inner perforate member has a plurality of radially dispersed openings constructed and arranged for strain-free engagement of a plurality of cables so that the said inner perforate member returns to its original configuration after the cables have been inserted therethrough." and p.8, line 18, wherein it is stated that "A plurality of radial slits 26 extend through the inner perforate member 14 in one to one correspondence with the apertures 25 so that each radial slit 25 extends from said center point of the disk to said intersect the corresponding aperture 25."

It is respectfully submitted that these limitations define over Napiorkowski as described in FIGS. 1-5 since it does not require additional material or positioning of one patterned surface over another for use.

The Examiner states in the rejection "the inner perforate member returns to its original configuration, due to the elastic material of construction." It is believed the Examiner holds the position once the cables, or wires are removed from the grommet, it will return to its original configuration due to the elastic material of construction. (Emphasis added) First, the construction of strain-free engagement of a plurality of cables, as defined throughout the instant specification, permits the inner perforate

member to return to its "original configuration after the cables have been inserted therethrough." In other words, once the cables or wires have been inserted through the inner perforate member (14) of the instant invention, and placed into one of the radially arranged apertures (25), the inner perforate member (14) is flush with the annular shoulder portion (18). That is, no part of the perforate member (14) axially extends beyond the annular shoulder portion (18), or is "splayed out", resulting in an untidy appearance (see paragraph bridging page 7 to 8 of the specification and original claims 1,4).

In contrast, the grommet (2) of Napiorkowski as described in the instant specification, (page 3, 1st full paragraph) do not teach the inner perforate members returning to their original configuration. In utilizing this grommet, once the cables or wires, have been inserted through the inner perforate member (12) and positioned along the radial edge (20) of the wedge (18) and through an aperture, e.g., (14) or (16), these wedge portions (18) would become randomly "splayed out" or extend beyond the annular shoulder of the annular peripheral section (4). Therefore, the wedge portions (18) do not return to their original configuration upon passage of a plurality of cables through the inner perforate members (12) and (14).

Accordingly, the limitation of independent claims 1 and 4 "said inner perforate member...constructed and arranged for strain-free engagement of plurality disparate cable combination; whereby upon passage of said plural disparate combination of cables therethrough, said inner perforate member returns to its original configuration" is not anticipated in Napiorkowski. Moreover, Napiorkowski fails to specifically disclose the material of membrane (6) in FIGS. 1-5 as an elastic material as suggested by the Examiner. Rather Napiorkowski states the entire grommet (2) may be formed from "any known flexible rubberlike material", column 3, lines 12-15, which may or may not return to its original configuration absent a specific teaching as to what characteristics the "rubberlike material" comprises.

Similarly, the alternative embodiment of grommet (40) shown in Figures 6-7 of Napiorkowski et al , illustrates membrane surfaces (42) and (44) containing a gel (52) which flows completely around the inner perforate member 12 the wires inserted therethrough to effect the desired seal. There is no teaching of an inner perforate member having "a plurality of radially dispersed openings". Thus absent a teaching of openings formed therein, this embodiment of Napiorkowki does not anticipate the instant invention.

Thus it is respectfully submitted that the claims are allowable over the Napiorkowki, and it is requested that this rejection be withdrawn.

Rejection under 35 USC 103(a)

Claims 2-3, 5-6 stand rejected under 35 U.S.C. 103(a) as being obvious over Napiorkowki.

The Examiner concedes that the Napiorkowki *et al* reference does not teach the use of the specific materials of construction recited in claims 2-3 or 5-6. Examiner goes on to state that it would have been obvious to one having ordinary skill in the art at the time of the invention was made to have elected the use of such materials, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability of the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v. Allied Industries of Kansas, Inc.* (DC KANS) 205 USPQ 331. Such a modification is not critical to the design and would have produced no unexpected results.

It is respectfully submitted that in order to establish a proper *prima facie* case of obviousness, three basic criterial must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not base on applicant's disclosure *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP §2143-§2143.03.

First, the Examiner has failed to establish a *prima facie* case of obviousness since it is not sufficient to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which the rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. Examiner has not supplied evidentiary support for forming the grommet (2) of Napiorkowki from two different materials, such as a first material of polypropylene or a second material being a thermal elastic elastomer, since Napiorkowski *et al* teaches the grommet (2) in FIGS. 1-5 being formed from a single known homogenous, flexible rubberlike material, see column 3, lines 12-15. Moreover, modification is not a mere matter of design choice since the

specification specifically recites the desirability of the outer peripheral member being formed from a first rigid material having sufficient mechanical stiffness for effective frictional engagement with a planer surface and an inner perforated member being formed from a second flexible material that is able to be overmolded using conventional injection molding techniques to said outer peripheral member to form a unitary grommet (see for third full paragraph on page 5 of specification).

Thus it is respectfully submitted that the claim 1 and dependent claims 2-3, 5-6 now read over the Napiorkowki et al reference, and it is requested that this rejection be withdrawn.

SUMMARY

In light of the foregoing remarks and amendment to the claims, it is respectfully submitted that the Examiner will now find the claims of the application allowable. Favorable reconsideration of the application is courteously requested. The Examiner is urged to telephone the undersigned in order to expedite prosecution of the instant application.

Respectfully submitted,



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Amendments to the Drawings:

The attached sheet includes a new corrected FIGURE 1 identical to the originally filed FIGURE 1 without shading such that the details are clear after scanning.

Attachment:

Annotated Sheet Showing Changes in Figure 1.